



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/578,631

05/25/2000

William H. Barber

387953

5757

30955

7590

03/09/2006

LATHROP & GAGE LC  
4845 PEARL EAST CIRCLE  
SUITE 300  
BOULDER, CO 80301

EXAMINER

MCALLISTER, STEVEN B

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/578,631

Applicant(s)

BARBER ET AL.

Examiner

Steven B. McAllister

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-83 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

In view of the arguments filed on 9/26/2005, PROSECUTION IS HEREBY REOPENED. A non-final office action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
**ALEXANDER KALINOWSKI**  
**SUPERVISORY PATENT EXAMINER**

### ***Finality Withdrawn***

The finality of the Office Action dated 3/30/2005 is withdrawn. Due to application of new art in the case, this Office Action is also Non-final.

### ***Response to Amendment***

The Declaration filed on 1/4/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome any reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of any reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

As read and understood by the examiner, the declaration and supporting evidence do not show conception of the claimed invention at any time prior to the filing of the non-provisional application. For instance, the examiner is able to find no evidence of conception of transmitting an electronic receipt for the transaction to a user specified address in the billing information.

#### ***Note Regarding Examination***

It is noted that the provisional application does not provide an enabling disclosure of the claimed invention. For instance, the examiner is not able find disclosure of of transmitting an electronic receipt for the transaction to a user specified address in the billing information. Since no claim is enabled by the provisional application, the effective filing date regarding the present claims is the date of the non-provisional application.

#### ***Claim Rejections - 35 USC § 112***

Art Unit: 3627

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 8 and 49 recite reading a signal from a flag on a casing that is returned with the optical media. However, the specification does not show setting or reading the flag sufficiently to enable one of ordinary skill in the art to make or use the invention without undue experimentation. Page 4, lines 25-35 describe a togglable flag on the case, but it is not clear how it is constructed, what reading means reads the flag, etc.

Alternatively, if it is found that a full enabling disclosure is not necessary, a rejection that this element is old and well known is presented below.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 66 recites depending from itself.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 18-19, 22, 26-29, 34-39, 41-52, 59-60, 63, 69, 70, 75-80, 82 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al (5,934,439) in view of Amos (6,554,184).

Kanoh et al show kiosks 3, which dispense CDs, see col. 1, lines 7-12, and receive them back. The kiosks of Kanoh et al are connected to a remote host computer 50, see col. 5, lines 33-40. Kanoh et al include a reader 61 that reads bar codes on the CDs and indicates when a CD is erroneously returned, see col. 6, lines 13- 16. Kanoh et al maintain an inventory of the rented CDs and the location of the CDs in the kiosk, see col. 7, lines 35-64. Kanoh et al disclose electronic transmission of charges to a credit card company, see col. 4, lines 28-31 and 47-49 and col. 9, lines 43-50 and col. 10, lines 5-12. However, Kanoh et al do not disclose electronically transmitting a receipt to the user address in the billing information. Amos shows this element (see e.g., col. 2, line 65 – col. 3, line 5). It would have been obvious to one of ordinary skill in the art to modify the method and apparatus of Kanoh by providing the email receipt of Amos in order to present the information to the user in a form which can be electronically placed

in a accounting software, such as Quicken, and in order to provide the user with a notification of sale of an overdue CD to the renter.

As to claims 2 and 44, Kanoh et al in view of Amos show all elements of the claim except for reading data from the optical storage media in the kiosk and displaying the data on a display. However, the examiner takes official notice that it is notoriously old and well known in the art to do so. For instance, it is old and well known to read the data from a CD or DVD in order to show the contents on the display or play parts of the content. It would have been obvious to one of ordinary skill in the art to further modify the method and apparatus of Kanoh by reading data from the optical storage media in the kiosk and displaying the data on a display in order to provide information to the user.

As to claim 4, Kanoh et al in view of Amos show an optical reader comprising the bar code reader.

Alternatively, as to claims 4-6, 46 and 47, Kanoh et al in view of Amos show all elements of the claim except an optical media reader, and instructions for the kiosk to read the returned media, detect and error, and record an indication that the media contains an error in response to the detection of an error. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to provide an optical media reader, and instructions for the kiosk to read the returned media, detect and error, and record an indication that the media contains an error in response to the detection of an error in order to avoid selling or renting defective media, therefore increasing customer satisfaction.

As to claims 7, 8, 48 and 49, Kanoh et al in view of Amos show all elements of the claim except receiving a signal from the user that the returned media contains and error wherein the signal is read from a flag on the media casing. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the method and apparatus of Kanoh by receiving a signal from the user that the returned media contains and error wherein the signal is read from a flag on the media casing in order to detect problem disks and remove them from circulation or repair them.

As to claims 26, 67 and 68, Kanoh et al in view of Amos show all elements of the claims except providing an ISP, a third processor at the ISP; programming at the ISP for transmitting messages between the kiosk and server; a tangible media for storing the programming; and the kiosk and server configured to communicate via the ISP; and sending messages via the internet. However, the examiner takes official notice that to provide these elements is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Kanoh by providing these elements and sending message via the internet in order to take advantage of the preexisting infrastructure of the internet.

As to claims 34, 35, 75 and 76, Kanoh et al in view of Amos show all elements of the claims except that the receipt includes advertisements comprising promotions for items available at the kiosk. However, the examiner takes official notice that to provide advertisements comprising promotions for items available by the seller is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art



to further modify the apparatus and method of Kanoh by providing such advertisements in order to stimulate more business.

As to claims 36-38 and 77-79, Kanoh et al in view of Amos show all elements of the claims except including a link to a home page in the receipt showing promotions offered by the seller. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Kanoh by providing link to a home page in the receipt showing promotions offered by the seller in order to stimulate additional business.

As to claims 39, 41, 42, 80, 82 and 83, Kanoh et al in view of Amos show providing a media via a dispenser, a slot for returning the media, a reader proximate the retrieval slot, instructions to read an identifier, and determine whether the media belongs to the system. It does not show that the dispenser providing a casing having an identifier; reading an identifier from the casing, or opening the slot upon determining that the media belongs to the system. However, the examiner takes official notice that to do so is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to further modify the apparatus and method of Kanoh by having a dispenser providing a casing having an identifier; reading an identifier from the casing, and opening the slot upon determining that the media belongs to the system in order to protect the media, and ensure that only the correct media owned by the system is returned.

Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claim 1 above further in view of Reid et al.

Kanoh et al, as modified by Amos, show all the features of the applicant's claimed invention except a storage carousel. Reid et al show a storage carousel 32 for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Reid et al for the storage means of Kanoh et al since they are equivalent and either would work equally well in the dispenser of Kanoh et al.

Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claim 1 above further in view of Crooks et al (5,007,518).

Kanoh et al, as modified by Amos, show all the features of the applicant's claimed invention except a storage carousel. Crooks et al show a storage carousel for holding the articles. It would have been obvious to one of ordinary skill in the art to substitute the carousel of Crooks et al for the storage means of Kanoh et al since they are equivalent and either would work equally well in the dispenser of Kanoh et al.

As to claim 11, Kanoh et al inherently show the kiosk processor adding a storage media to the inventory in response to receiving one from the user. It is noted that the kiosk tracks inventory since it is able to determine whether a requested tape number is in stock and and is able to determine its location in the machine.

As to claim 12, Kanoh et al show all elements since it shows providing an update of inventory comprising an update of items rented in response to updating the inventory in the kiosk after a rental.

Alternatively as to claim 12, Kanoh et al in view of Amos and Crooks et al show the limitation since Kanoh shows providing updated information related to inventory in response to updating inventory data at the kiosk after a rental and Crooks et al show sending an updated inventory to the host from the kiosk.

Claims 13 and 54 are Claims 13 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claim 1 above further in view of Takahashi et al.

Kanoh et al, as modified by Amos, disclose all the features of the applicant's claimed invention except the device to polish the CDs. Takahashi et al show a CD polishing device. It would have been obvious to one of ordinary skill in the art in view of the CD polishing device shown in Takahashi et al to provide the device of Kanoh et al with a device to polish the CDs to repair damaged disks.

Claims 14 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos and Takahashi et al as applied to claims 13 and 54 above further in view of Crooks et al.

Kanoh et al show an optical reading mechanism (comprising a bar code reader) in the kiosk; and directing the kiosk cpu to read the optical storage media, comprising reading the bar code on the CD (note that Kanoh contemplates renting CDs as well as

Art Unit: 3627

tapes). The combination does not show performing an error checking routing on the media or generating an indicia of an error. Crooks et al show performing an error checking routine comprising asking the user to enter whether the media is damaged; and generating an indicia of an error on the media comprising setting the status of the tape as unavailable. It would have been obvious to one of ordinary skill in the art to further modify the method and apparatus of Kanoh by providing the elements taught by Crooks et al in order to avoid renting damaged media.

Claims 20, 21, 53, 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 1, 43 and 50 above, and further in view of Hirschfeld et al (4,903,815).

Kanoh et al in view of Amos show all elements except maintaining an inventory at the server. Hirschfeld et al show maintaining an inventory at the server. It would have been obvious to one of ordinary skill in the art to further modify the method and apparatus of Kanoh et al by providing inventory at the server in order to provide for sharing of the inventory information with other processors, in order to facilitate providing an overall inventory of items in the plurality of kiosks, and in order to maintain a redundant source of the data in case of damage to the kiosk.

As to claims 21 and 62, the combination shows the server providing inventory access to another processor 424.

Claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 27 and 70 above, and further in view of Brindze et al.

Kanoh et al, as modified by Amos, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. Brindze et al show CDs with unique concentric markings to keep track of each CD. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Brindze et al to provide the CDs of Kanoh et al with unique concentric markings to keep track of each CD. (It is noted that the markings of Brindze are concentric since they have the same center. It is noted that the a plurality of concentric rings was not claimed.)

Alternatively, claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 27 and 70 above, and further in view of JP 7-182659.

Kanoh et al, as modified by Amos, disclose all the features of the applicant's claimed invention except concentric markings on the CDs. '659 show CDs with unique concentric markings around the center of the CD (see English abstract and Figures). It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of '659 to provide the CDs of Kanoh et al with concentric bar code in order to allow rapid reading of code and reading regardless of angle.

Alternatively, claims 30-32, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 27 and 70 above, and further in view of Tone et al (5,107,667)

Kanoh et al, as modified by Amos, disclose all the features of the applicant's claimed invention except that the bar code is made of concentric circles and is concentric around the center of the object. Tone et al show this element (see Figs. 4, 5). It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Tone to provide the CDs of Kanoh et al with concentric bar code in order to allow reading regardless of angle.

Claims 33, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 1 and 43 above further in view of lida.

Kanoh et al, as modified by Amos, show all the features of the applicant's claimed invention except an optical writing system. lida disclose an optical writer 28 that writes data requested and received from a server to the CDs. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of lida to provide the device of Kanoh et al with an optical writer in order to write data to the CDs.

Claims 23-25 and 64-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 1 and 43 above further et al in view of Dedrick.

Kanoh et al, as modified by Amos, show all the features of the applicant's claimed invention except sending advertisements according to a user profile based on items the user has requested in previous transactions. Dedrick discloses sending advertisements according to a user profile. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Dedrick to tailor the advertisement in Kanoh et al according to user profiles.

Alternatively, as to claims 25 and 66 Kanoh et al in view of Amos and Dedrick show all elements except

Claims 39-41 and 80-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanoh et al in view of Amos as applied to claims 1 and 43 above further in view of lida.

Kanoh et al, as modified by Amos, show all the features of the applicant's claimed invention except a casing with an address and packaging for mailing. lida discloses a casing and address label and packaging for mailing the CDs in col. 15, lines 16-22. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of lida to provide the device of Kanoh et al with a casing and means to address and mail the CDs.

***Allowable Subject Matter***

Claims 15-17 and 56-58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-83 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



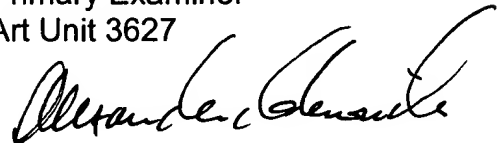
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven B. McAllister

STEVE B. McALLISTER  
PRIMARY EXAMINER

Steven B. McAllister  
Primary Examiner  
Art Unit 3627



ALEXANDER KALINOWSKI  
SUPERVISORY PATENT EXAMINER